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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/342,719 06/29/99 ROE

D 75900

EXAMINER

QM12/1001

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CINCINNATI OH 45224

KIDWELL, M

ART UNIT

PAPER NUMBER

3761

DATE MAILED:

10/01/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/342,719

Applicant(s)

ROE ET AL.

Examiner

Michele M. Kidwell

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-32, 34-44, 47-49 and 58-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-32, 34-44, 47-49 and 58-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Priority***

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

### ***Specification***

The disclosure is objected to because of the following informalities: On page 58 of the specification, the language reading "corresponding to U.S. Application..." should either be completed or deleted.

Appropriate correction is required.

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***Claim Objections***

Claim 37 is objected to because of the following informalities: the second occurrence of "a" should be removed in line 2. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28 – 32, 34 – 44, 47 – 49 and 58 – 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites the following limitations:

- "the removability" in line 2
- "the skin" in line 3
- "said skin" in line 4
- "the test methods" in line 6

There is insufficient antecedent basis for these limitations in the claim.

Regarding claim 34, it is unclear what the applicant intends to claim as an invention.

The applicant states "...an effective amount of a feces modifying agent" in line 2.

However, what constitutes an effective amount (i.e., an effective amount to coat the topsheet, an effective amount to be seen by the naked eye, etc.). Correction is required.

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With respect to claims 42, it is unclear if the listed components of the groups are intended to be listed as a Markush group. If so, there is only one acceptable form of alternative expression which recites members as being "selected from the group consisting of A B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

Claim 58 recites the following limitations:

- "the removability" in lines 1 and 4
- "the skin" in lines 1, 5 and 7
- "the test methods" in line 9
- "the equation" in line 11

There is insufficient antecedent basis for these limitations in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28 – 32, 34, 36, 38 – 44, 47 – 48 and 58 – 59, as best understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Srinivasan et al. (US 3,913,579).

Regarding claim 28, Srinivasan et al. (hereinafter "Srinivasan") discloses a disposable article adapted to be worn by a wearer (abstract) comprising one or more compositions for enhancing the removability of fecal waste from the skin of the wearer, said one or more compositions being available to at least a portion of one of said fecal waste and said skin of said wearer wherein said one or more compositions provide one or more of the following as determined by the test methods set forth in the specification (a) a Waste Contamination Area of less than about 15 cm<sup>2</sup> ;(b) a Waste Contamination Mass calculated from the equation as set forth in col. 3, lines 34 – 60.

Srinivasan discloses the incorporation of carboxymethyl cellulose into the cover of an absorbent article which, as disclosed on page 55 of the applicant's specification, yields the claimed test results.

With reference to claims 29 – 32, 34, 36, 38 – 44 and 47 – 48, see col. 3, lines 34 – 60.

As to claim 58, see the rejection of claim 28.

Regarding claim 59, see col. 3, lines 34 – 60.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35, 37 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan as applied to claims 28 – 32, 34, 36, 38 – 44, 47 – 48 and 58 – 59 above, and further in view of Duncan et al. (US 3,489,148).

The difference between Srinivasan and claim 35 is the provision that the disposable article comprise a skin care composition.

Duncan et al. (hereinafter "Duncan") teaches an absorbent article comprising a skin care composition as set forth in col. 2, lines 32 – 40.

It would have been obvious to one of ordinary skill in the art to modify the compositions as disclosed by Srinivasan to employ a skin care composition because the use of a skin care composition reduces the possibility of an infant developing diaper rash due to waste fluid and/or fecal matter as taught by Duncan in col. 2, lines 27 – 31.

As to claim 37, see col. 3, lines 20 – 44.

As to claim 60, see the rejection of claim 35.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 49 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,160,198 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both the instant application and the U.S. Patent disclose a disposable article to be fitted to a wearer comprising a responsive system including a sensor operatively connected to said article, the sensor adapted to detect an input, and an actuator adapted to perform a responsive function when the sensor detects the input.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele M. Kidwell whose telephone number is 703-305-2941. The examiner can normally be reached on Monday thru Friday, 7:00am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John G. Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.



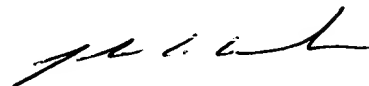
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

*Michele Kidwell*  
Michele Kidwell  
September 24, 2001

A handwritten signature in cursive script, appearing to read "J. Smith".